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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,064	11/16/2001	Bernadette Gibbs	53394.000520	7549

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EXAMINER

WEBB, JAMISUE A

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 05/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/988,064

Applicant(s)

GIBBS ET AL.

Examiner

Jamisue A. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) 51-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-50 and 57-62 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- ☐ Interview Summary (PTO-413) Paper No(s). ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

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DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-50 and 57-62, drawn an absorbent article, classified in class 604, subclass 386.
 - II. Claims 51-56, drawn to a method of determining stretchability, classified in class 73, subclass 760.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the method of determining the stretchability can be used to make a product that is different from the product in Invention I, for example, it can be used to make a product with a waist region that stretches less than 125% of its original length.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Patrick Doody on 4/24/03 a provisional election was made with traverse to prosecute the invention of the article, claims 1-50 and 57-62.

Affirmation of this election must be made by applicant in replying to this Office action. Claims

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51-56 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-36, 43, 45, 48-50, 57-62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claims 1, 43, 57 and 60 recite the limitation "the waist region that includes the connection mechanism". There is insufficient antecedent basis for this limitation in the claims. The claims previously state that the connection mechanism is adjacent a waist region, not that they are located in the waist region.

9. Claims 13, 28, 34, 48, 57, and 60 recite the limitation "the number of stages". There is insufficient antecedent basis for this limitation in the claims.

10. With respect to Claims 13-15, 28-30, 34-36, 48-50, and 57-62: these claims disclose the stretchabilities of diapers for newborn babies, crawling babies and walking babies. Are these the

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stages that are being disclosed in Claims 13, 28, 34, 48, 57 and 60 and if they are, the MaxStretch is an average, accumulative term, therefore how can one get the maximum stretchability for different stages? Furthermore it should be noted that “for newborn babies”, “for crawling babies” and “for walking babies” are terms of intended use, and it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-12, 16-27, and 37-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Roe et al. (5,749,866).

13. With respect to Claims 1-3, 6-12, 19-21, 37, 38, and 41-47: Roe discloses the use of an absorbent article (20) with a topsheet (24), backsheet (26) and core (28) located there between. Roe discloses the use of a back waist region (46), a front waist region (45) and a crotch region located there between (see all Figures). Roe discloses two connection mechanism (36) each containing gripping mechanisms (40) adjacent the back waist region and a target strip (41) located in the front wait region, and where the back waist region stretches 50% (therefore 150% of its original length) with 5 g/cm force (column 12, lines 2-4). Therefore if an 800 gram force is

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applied to a 4 inch wide cut portion (800g/4inch or approximately 79 g/cm), then it is the examiners position that the waist regions will stretch more than 50% (150 times its original length). Roe also discloses the side panels, which are the connection mechanisms to have a 500% extension with a 15g/cm force.

14. With respect to Claims 4, 5, 39 and 40: Roe discloses an alternative fastening system to a tape tab uses hook and loop type fasteners (column 32, lines 2-20).

15. With respect to Claims 16-18, 22-27: Roe discloses that in the width direction of the web that forms the side panels (connection mechanisms) and the waist regions, the material is capable of stretching over 100%, with just about 500 g/inch. It is the examiner's position that the stretchability of the width of the waist region and the connection mechanisms is the stretchability of the base web itself, due to the fact that the web is only crimped in one directions (the length). The claims state a 4 inch wide laterally cut portion, the claim does not set forth the longitudinally cut portion, therefore with a cut portion of 1 inch, it would give a force of 1000 or 1200 g/inch. According to Figure 5, this will give an elongation well over 100% (200%) its original length. Therefore it is the examiner's position that the waist region will have a stretch greater than 140% of its original length and the connection mechanism will have a stretch over 220% its original length.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

18. Claims 13-15, 28-33, 34-36, 48-50, 57-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roe et al. (5,749,866).

19. With respect to Claims 13-15, 28-33, 48-50, and 57-59: Roe discloses the use of an absorbent article (20) with a topsheet (24), backsheet (26) and core (28) located there between. Roe discloses the use of a back waist region (46), a front waist region (45) and a crotch region located there between (see all Figures). Roe discloses two connection mechanism (36) each containing gripping mechanisms (40) adjacent the back waist region and a target strip (41) located in the front wait region, and where the back waist region stretches 50% (therefore 150% of its original length) with 5 g/cm force (column 12, lines 2-4). Therefore if an 800 gram force is applied to a 4 inch wide cut portion (800g/4inch or approximately 79 g/cm), then it is the examiners position that the waist regions will stretch more than 50% (150 times its original length).

20. Roe also discloses the side panels extending 43mm from the side edge of the back waist (column 26, lines 36-38) and has an available stretch of 110% (210% the original length)

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(column 25, lines 55-57), the front waist and rear waist having a length of 180mm and an available stretch of 60% or 160% the original length (column 25 line 37-50 and column 28 lines 19-28). Therefore this would give a Max stretch of the entire circumference (Max Stretch of side panels, plus Max Stretch of front waist region plus Max Stretch of back waist region), using the claimed invention where $n=1$, of approximately 170%. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the Max Stretch of the waist circumference to be greater than about 185%, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 372, 205 USPQ 215)

21. With respect to claiming that it is for a newborn, for a walking baby and for a crawling baby, these are all considered functional limitations and it is the examiner's position that the article of Roe is perfectly capable of being worn by all of these stages.

22. With respect to Claims 34-36 and 60-62: As it would be obvious to have the MaxStretch greater than 185%, and as explained above how the diaper is perfectly capable of being worn for a newborn, crawling and walking baby, then having the MaxStretch be 185 for all of these, would result in a stretchability index of greater than 540 for each of these.

Conclusion

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lavon et al. (5,669,897) discloses the use of side panels having an extension of 50% at 200g/in., Heki et al. (5,906,008) and Toyoda et al. (5,916,207) disclose the use of stretchable side panels, Chen et al. (5,061,262) and Torimae et al. (4,787,897) disclose elastic fastener tabs

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that are extensible, Van Gompel et al. (4,938,753) disclose a pant like article having an elasticity up to 300% and Price et al. (US 2003/0028166 A1) discloses a stretch stress in the waist regions of 100-400%.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (703) 308-8579. The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (703)308-1957. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

jaw
April 29, 2003


WEILUN LO
SUPERVISORY PATENT EXAMINER
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